



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,744	02/14/2001	Michael R. Miller	150-123CIP14	2177

7590 03/21/2005

WILLIAM FRITZ  
NEOMEDIA TECHNOLOGIES, INC .  
2201 SECOND STREET  
SUITE 600  
FORT MYERS, FL 33901

EXAMINER

PEREZ DAPLE, AARON C

ART UNIT	PAPER NUMBER
----------	--------------

2154

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/783,744

Applicant(s)

MILLER ET AL.

Examiner

Aaron C Perez-Daple

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This Action is in response to Application filed 2/14/01.
2. Claims 1-18 are presented for examination.
3. This Action is non-Final.

### ***Priority***

4. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Specifically, priority application 09/296,479 does not disclose the steps of presenting a button on a display screen for a first website and a second website and capturing the identity of products on the respective websites upon selecting the button. Because these steps are recited in independent claims 1, 7 and 13 of the present application, claims 1-18 are not entitled to the benefit of application 09/296,479.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Art Unit: 2154

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 13-18** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the claims are directed towards “logic,” which the Examiner reasonably interprets may consist of software. Software *per se* in non-statutory when it is not tangibly embodied. See MPEP 2106 IV.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-18** are rejected under 35 U.S.C. 102(e) as being anticipated by Franklin et al. (US 6,125,352) (hereinafter Franklin).

9. As for claims 1, 7 and 13, Franklin discloses a method, computer program product and system for allowing selection of products while navigating multiple websites, comprising the steps of:

(a) presenting a button on a display screen displaying a web page of a first website, wherein the web page has information about a first product thereon (col. 2, line 56 – col. 3, line 2; col. 11, lines 1-10);

Art Unit: 2154

(b) capturing an identity of the first product upon selection of the button (col. 2, line 56 – col. 3, line 2; col. 11, lines 1-10);

(c) presenting the button on the display screen upon displaying a web page of a second website, wherein the web page of the second website has information about a second product thereon (col. 3, lines 2-14; col. 11, lines 1-10);

(d) capturing an identity of the second product upon selection of the button (col. 3, lines 2-14; col. 11, lines 1-10);

(e) placing the identities of the products in a list (shopping basket; col. 2, lines 47-51);  
and

(f) outputting at least a portion of the list (view shopping basket; col. 2, lines 47-51).

10. As for claims 2, 8 and 14, Franklin discloses the method as recited in claim 1, wherein identities of alternative products are also output (col. 8, lines 19-29).

11. As for claims 3, 9 and 15, Franklin discloses the method as recited in claim 1, wherein information about a vendor of the products listed on the portion of the list is output (col. 9, lines 5-14; col. 9, lines 29-42).

12. As for claims 4, 10 and 16, Franklin discloses the method as recited in claim 3, wherein the vendor is selected based on the number of products on the portion of the list that are available from the vendor (col. 9, lines 29-41).

13. As for claims 5, 11 and 17, Franklin discloses the method as recited in claim 3, wherein the vendor is selected based on at least one of prices of the products, proximity to the vendor, availability of delivery, whether the products are in stock, wrapping availability, shipping availability, tracking availability, and a loyalty program (col. 9, lines 29-41).

Art Unit: 2154

14. **Claims 1, 7, and 13** are further rejected under 35 U.S.C. 102(e) as being anticipated by Godden et al. (US 6,401,077 B1) (hereinafter Godden).
15. As for claims 1, 7 and 13, Godden discloses a method, computer program product and system for allowing selection of products while navigating multiple websites, comprising the steps of:
- (a) presenting a button on a display screen displaying a web page of a first website, wherein the web page has information about a first product thereon (col. 3, lines 2-28);
  - (b) capturing an identity of the first product upon selection of the button (col. 3, lines 24-28);
  - (c) presenting the button on the display screen upon displaying a web page of a second website, wherein the web page of the second website has information about a second product thereon (col. 3, lines 2-28; col. 5, lines 24-47);
  - (d) capturing an identity of the second product upon selection of the button (col. 3, lines 24-28);
  - (e) placing the identities of the products in a list (shopping cart; col. 3, lines 2-28); and
  - (f) outputting at least a portion of the list (col. 3, lines 2-28).

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. **Claims 6, 12 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin. As for claims 6, 12 and 18, Franklin teaches outputting the list to a client device (consumer computer, Fig. 1), but does not explicitly disclose that the client device may be portable. "Official Notice" is taken that it is both known and expected in the art to use a portable client device, such as a laptop computer. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Franklin by using a portable client device, such as a laptop computer, for the purpose of providing added convenience to the user.

### *Conclusion*


18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 6,754,636, note abstract, cols. 7-8; US 6,535,880 B1, note abstract; US 5,664,110, note abstract.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron C Perez-Daple whose telephone number is (571) 272-3974. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information

Art Unit: 2154

for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 3/16/05

Aaron Perez-Daple

 JOHN FOLLANSBEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2154